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In re Application of
Conrad Alexander et al
Application No. 08/421,810
Filed: April 13, 1995
For: INTELLIGENT LOCATOR SYSTEM

DECISION ON PETITION UNDER
37 CFR § 1.181(a)(3)

This is a decision on the petition under 37 C.F.R. § 1.181(a)(3) and 1.183, filed September 21, 1998, to enter applicant's amendment dated March 4, 1998. This decision treats the 37 CFR § 1.181(a)(3) portion of the petition.

The file history leading up to the petition began with the application being remanded to the examiner from the Board of Appeals on May 22, 1998 in order to consider the appropriateness of the amendment filed May 19, 1998. The examiner responded by sending an Advisory Action on June 8, 1998 denying entry of the amendment. On August 13, 1998 the application was again remanded to the examiner from the Board of Appeals in order to reconsider the decision requesting the amendment filed on May 19, 1998 be entered. The examiner responded by again sending an Advisory Action on August 17, 1998 denying entry of the amendment.

The reasons raised by the petitioner for entering the amendment filed on May 19, 1998 include, the fact that on May 6, 1997 United States Patent No. 5,627,524 was issued in the name of Fredrickson et al on an application filed March 2, 1995 which is a continuation of an application file June 7, 1993. Applicants filing date pursuant to 35 U.S.C. § 120 is October 7, 1992. The amendment filed May 19, 1998 presented claims copied from the Fredrickson et al Patent No. 5,627,524 for the purpose of provoking an interference. The examiner denied entry of the amendment based on the fact that the amendment was untimely and necessitates a new search, raises new issues of new matter, presents additional claims without the cancellation of a corresponding number of finally rejected claims, raises the new issue of an interference, and does

not simplify issues for appeal. The applicants state in the petition that based on the facts enumerated above, an interference could not have been sought anytime prior to May 6, 1997, which was after Applicant's Appeal Brief and Examiner's Answer were filed. Also stated, the applicants believe they are entitled to this amendment to invoke an interference as set forth under 37 C.F.R. § 1.607 and that denying entry is inequitable in that it denies applicant access to an interference merely based upon the presence of a final rejection.

In order for an Amendment to be entered that presents claims for interference with a patent after prosecution of the application is closed, the amendment must comply with section MPEP § 2307.03 as stated below:

> 2307.03 Presentation of Claims for Interference With a Patent, After Prosecution of Application is Closed
>
> An amendment presenting a claim to provoke an interference in an application not in issue is usually admitted and promptly acted on. However, if the case had been closed to further prosecution as by final rejection or allowance of all the claims, or by appeal, such amendment is not entered as a matter of right.
>
> An interference may result when an applicant presents claims to provoke an interference with a patent which provided the basis for final rejection. Where this occurs, if the rejection in question has been appealed, the Board of Patent Appeals and Interferences should be notified of the withdrawal of this rejection so that the appeal may be dismissed as to the involved claims.
>
> Where the prosecution of the application is closed and the presented claims relate to an invention distinct from that claimed in the application, entry of the amendment may be denied (Ex parte Shohan , 1941 C.D. 1 (Comm'r Pat. 1940)). Admission of the amendment may very properly be denied in a closed application, if prima facie , the claims are not supported by the applicant's disclosure. An applicant may not have recourse to presenting a claim corresponding to a patent claim which applicant has no right to make as a means to reopen or prolong the prosecution of his or her case. See MPEP § 714.19(4).

In the instant application, the amendment is not entered as a matter of right as evidenced by the examiner's Advisory Actions. Additionally, the presented claims relate to an invention that is distinct from that claimed in the application as evidenced by the numerous new limitations added that were not previously considered in the finally rejected claims as outlined in the Advisory Action of June 8, 1998. Furthermore, the non-entry of the claims does not deny applicant access to an interference. (The claims submitted by applicant to provoke an interference were filed within one year from the issuance of the patent in question.) Applicant should consider filing a continuing application under 37 CFR § 1.53 to provoke an interference.

The Petition is **DENIED.**

The application file is being forwarded to the Special Programs Law Office, Office of Petitions for treatment of the alternative petition under 37 CFR § 1.183.

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